

REMARKS

Applicant requests favorable reconsideration and withdrawal of the objection and rejections set forth in the above-noted Office Action in view of the foregoing amendments and following remarks.

The Office Action objects to the specification for incorporation of essential material in the specification by reference to other documents. The Office Action asserts that the application must be amended to include the material incorporated by reference if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office.

Applicant traverses this objection on the grounds that the originally-filed specification, even without consideration of the material incorporated by reference, includes a description of the claimed invention so as to satisfying the requirements of 35 U.S.C. § 112. Note, 37 C.F.R. § 1.57(c) defines “essential material” with respect to material being incorporated by reference in terms of the requirements of 35 U.S.C. § 112. In this regard, the Office Action does not assert that any of the features of the claimed invention do not satisfy the requirements of the 35 U.S.C. § 112. Moreover, the Office Action does not identify what “essential material” it deems not found in specification, absent the material incorporated by reference. Accordingly, Applicant submits that specification does include all of the essential material of the invention without reference to the material incorporated by reference, that the Office Action fails to set for a prima facie objection to the specification for not including “essential material” but for the incorporation by reference, and thus, that the objection to the specification should be withdrawn.

Claims 1-33 remain pending, with claim 1 being the only independent claim. Claims 1, 24, and 26 have been amended. Support for the amendment can be found throughout the

originally-filed disclosure, including, for example at paragraphs 0048-0049 of the specification. Thus, Applicant submits that the amendments do not include new matter.

Claims 1-9, 11, 12, and 14-33 are rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. (WO 02/097561) in view of Biltis (WO 01/39077) and Maggioncalda et al. (WO 99/30261). Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. in view of Biltis, Maggioncalda et al., and Gallagher et al. (U.S. Patent Application Pub. No. 2004/0111367). Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. in view of Biltis, Maggioncalda et al., and VanLeeuwen (U.S. Patent Application Pub. No. 2002/0123949).

Applicant respectfully traverses the rejections. Nevertheless, in order to expedite prosecution, independent claim 1 has been amended so as to clarify features of the invention not disclosed or suggested by the cited references. To this end, Applicant submits that the claimed invention is patentably distinguishable from the cited references for at least the following reasons.

Amended independent claim 1 recites a savings and bill payment system that includes, inter alia, a debt analyzer configured to (1) analyze debt information, (2) provide a recommendation including a suggestion for minimizing an amount of a payment for an existing user debt and maximizing an amount of a payment to a user savings account, and (3) provide a payment hierarchy based at least in part on the recommendation, wherein the payment hierarchy includes at least a first portion of the user income allocated to the user savings account and a second portion of the user income allocated to the existing user debt. By virtue of these features, embodiments of the claimed invention may encourage a user to increase his or her savings by

prompting the user to think of savings first, and further by providing recommendations for aggressive savings. See, e.g., paragraphs 0046, 0048, and 0049 of the specification.

The Office Action cites Smith et al. as a primary basis for the rejection, and asserts that the reference discloses features of the invention including a debt analyzer. The Office Action acknowledges, however, that Smith et al. does not disclose that the debt analyzer is configured to provide a recommendation and/or a payment hierarchy, as in the claimed invention.

In order to cure this deficiency in Smith et al., the Office Action cites Maggioncalda et al. as disclosing a system wherein a recommendation is provided that includes a suggestion for minimizing an amount of payment for a user debt and maximizing an amount of payment to a user savings account, with Maggioncalda et al. further providing a payment hierarchy based at least in part on the recommendation, wherein the payment hierarchy includes at least a first portion of the user income allocated to a user savings account and a second portion of the user income allocated to user debt.

Applicants respectfully traverse the factual findings of the Office Action with respect to Maggioncalda et al., as well as the finding that the teachings of this reference in combination with Smith et al. would render obvious the claimed invention to one of ordinary skill in the art. In Applicant's view, Maggioncalda et al. does not disclose or suggest recommending the combination of minimizing an amount of payment on a user debt and maximizing an amount of payment to a user savings account. Instead, Maggioncalda et al. provides a system that recommends "financial products." See, e.g. p. 10, line 27 et seq. "Financial products" in Maggioncalda et al. includes financial obligations that a user of the instrument could buy or invest in, such as a mortgage or retirement account. See, e.g., p. 1, lines 12-23. The system of Maggioncalda et al. analyzes information provided by a user, runs simulations to project

outcomes of holding specific financial products, and then recommends particular financial products for the user to obtain based on the results of the simulation. P. 10, line 8 – p. 11, line 4. While the system of Maggioncalda et al. appears to consider what the payments will be on potential debts such as a mortgage that the user could obtain, the system does not recommend minimizing payment on an existing debt and maximizing payment to a user savings account, as in the claimed invention. In other words, while the system of Maggioncalda et al. may recommend the user obtain a mortgage that will have low payments, there is no indication that the system of Maggioncalda et al. would provide a recommendation to minimize the payments on an existing mortgage so that a user may maximize payments to a user savings account.

It is not surprising that the system of Maggioncalda et al. lacks a configuration to provide a recommendation to minimize payment on an existing debt and maximize payment to a user savings account, as in the claimed invention. Without the hindsight afforded by the disclosure of the present application, such features would most likely be counter-intuitive to one of ordinary skill in the art. In general, systems in the art are designed to encourage people to reduce their debt, which leads to the maximization of debt payments. The claimed invention, unlike previous art, provides novel and unobvious methods for get users to think about saving money prior to paying off debts. See, e.g., paragraph 0006 of the specification. There is no simply no indication that the system of Maggioncalda et al. is configured in this manner.

Applicant further submits that the other references cited in the Office Action to Biltis, Gallagher et al., and VanLeeuwen fail to cure the deficiencies of Smith et al. and Maggioncalda et al. That is, none of the other references cited in the Office Action discloses or suggests a debt analyzer with the configuration recited in amended independent claim 1.

For at least the foregoing reasons, Applicant submits that the present invention, as recited in independent claim 1, is patentably defined over all of the references cited in the Office Action.

The dependent claims also should be deemed allowable, in their own right, for defining other patentable features of the present invention in addition to those recited in the independent claim. Applicant requests further individual consideration of these dependent claims.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and an early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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